

REMARKS

Claims 1-40 are pending in this application. By this Amendment, claims 1, 12, 16, 18, 21-23 and 25 are amended. New claims 39 and 40 are added.

In particular, claims 1, 16 and 25 are amended for better clarity. Claims 12, 18 and 21-23 are amended to obviate informalities. Claims 39 and 40 are added to recite additional features described in the specification.

Applicant thanks Examiners Najjar and Jacobs for the courtesy extended to Applicant's representative, Mr. Luo, during the February 10, 2005 personal interview. The following remarks incorporate the substance of the personal interview, and thus satisfy the requirement under MPEP §713.04.

The Examiner is respectfully requested to consider the references submitted with the Information Disclosure Statement filed on January 26, 2005.

The Office Action rejects claims 1-38 under 35 U.S.C. §103(a) over U.S. Patent No. 6,363,357 to Rosenberg et al. in view of U.S. Patent No. 5,310,997 to Roach et al. This rejection is respectfully traversed.

A. Rosenberg and Roach Are Incompatible

The Office Action recognizes that Rosenberg does not disclose or suggest a controller that creates assigned delivery data contents, as recited in claim 1; means for creating assigned data contents, as recited in claim 16; or preparing delivery data contents for the specific requester by adding requester-specific data to duplicated data contents, as recited in claim 25. However, the Office Action asserts that Roach discloses these features. Applicant respectfully submits that, even if Roach does disclose such features, one of ordinary skill in the art would not have been motivated to combine Rosenberg and Roach.

Rosenberg discloses a method for online shopping. A buyer accesses a host computer's website from the buyer's computer to download digital content product. See col. 2, lines 44-57.

As is well known, such an online shopping method allows a user to download digital contents at the buyer computer without going to a shop or being accompanied by a sales person.

In contrast, Roach discloses a system in which a shopping mall may be arranged such that, when a customer visits the shopping mall, a sales person needs to be with the customer to record selected merchandise. See col. 8, line 67-col. 9, line 22 of Roach. The selected merchandise must be physically picked up or physically delivered. See col. 10, lines 3-30 of Roach.

One of ordinary skill in the art would not have been motivated to combine Rosenberg and Roach. For example, Roach requires that a customer physically go to a shopping mall in order to make a purchase. This would defeat the purpose of Rosenberg's online shopping method in which the customer stays at home and gets digital contents transmitted to the customer over a network.

B. The Alleged Motivation to Combine is Without Merit

As the alleged motivation to combine Rosenberg and Roach, the Office Action asserts that the combination would have been obvious "in order to store and retrieve information regarding the user purchase order in a timely and efficient manner." However, the Examiner is reminded that the Rosenberg apparatus is designed to allow the user to shop from the user's computer. As such, the system already inherently knows where to send the digital contents ordered by the customer, i.e., it knows to send the ordered digital contents to the customer's computer (because it is from the customer's computer that the order is being sent). There is no disclosure of Rosenberg's "first computer" having the option to electronically transmit data anywhere else in response to a given request. Thus, it is unclear how the suggested combination would have resulted in storage and retrieval "in a timely and efficient manner," beyond the timeliness and efficiency already achieved by Rosenberg. Should the rejection be maintained, Applicant requires clarification from the Examiner on this point.

C. Even If the Prior Art Were Combined, the Combination Would Not Have Resulted in the Claimed Combination of Features

Furthermore, Applicant respectfully submits that Rosenberg and Roach, even if combined, do not disclose or suggest a system to distribute merchandise data contents in a form of assigned delivery data contents, comprising a controller that creates assigned delivery data contents to be electronically transmitted from the first computer, as recited in claim 1; a delivery device which transmits merchandise data contents in the form of assigned data contents, comprising means for creating assigned data contents to be electronically transmitted from the delivery device, as recited in claim 16; or a method to distribute merchandise data contents in a form of delivery data contents, comprising preparing the delivery data contents for the specific requester by adding requester-specific data to the duplicated data contents, the delivery data contents to be electronically transmitted from the first computer, as recited in claim 25.

Roach discloses a pen-based sales transaction computer 18 that transmits a request of purchase to a controller 12. See Figs. 1 and 2, and col. 5, lines 62-65. The computer 18 creates a transaction record of the sale, and forwards the transaction record to the controller 12. See col. 5, lines 64-65. Thus, Roach discloses that the computer 18 both sends purchase requests and creates a transaction record. The controller 12 does not create, but merely receives the created transaction record.

Thus, the transaction record created by computer 18, as disclosed in Roach, merely contains information identifying a selected merchandise. It is not a form of the merchandise itself that is to be delivered to the customer. Thus, Roach does not disclose or suggest the creation of assigned delivery data contents. According to Roach, the merchandise to be delivered is hard goods, and thus there is no electronic transmission of the merchandise.

In view of the above, Roach does not disclose or suggest a controller that creates a transaction record, much less creating assigned delivery data contents in the form of which merchandise data contents are distributed. Therefore, Roach does not disclose or suggest a system to distribute merchandise data contents in a form of assigned delivery data contents, comprising a controller that creates assigned delivery data contents to be electronically transmitted from the first computer, as recited in claim 1; a delivery device which transmits merchandise data contents in the form of assigned data contents, comprising means for creating assigned data contents to be electronically transmitted from the delivery device, as recited in claim 16; or a method to distribute merchandise data contents in a form of delivery data contents, comprising preparing the delivery data contents for the specific requester by adding requester-specific data to the duplicated data contents, the delivery data contents to be electronically transmitted from the first computer, as recited in claim 25. Thus, Roach does not supply the subject matter lacking in Rosenberg. Hence, Rosenberg and Roach do not disclose or suggest the subject matter recited in claims 1, 16 and 25, and claims 2-15, 17-24 and 26-38 depending therefrom.

For at least the above reasons, withdrawal of the rejection of claims 1-38 under 35 U.S.C. §103(a) is respectfully requested.

New claims 39 and 40 are each patentable in view of the patentability of claims 1 and 16 from which they respectively depend, as well as for the additional features they recite.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-40 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:
Amendment Transmittal

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